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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/889,106   | 07/11/2001  | Haile Tecle          | 5940-01-SMH         | 7962             |
| 7590   | 10/20/2003  |                      | EXAMINER            |                  |
| Evelyn D Shen<br>Legal Division<br>Warner Lambert Company<br>201 Tabor Road<br>Morris Plains, NJ 07950 |             |                      | SHAMEEM, GOLAM M    |                  |
|  |             | ART UNIT             | PAPER NUMBER        |                  |
|  |             | 1626                 |                     |                  |
| DATE MAILED: 10/20/2003  |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

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|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 09/889,106             | TECLE ET AL.        |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Golam M M Shameem      | 1626                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 23 July 2003.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) 30-50 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) \_\_\_\_\_ is/are rejected.
- 7) Claim(s) 1-9, 11-24 and 26-29 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
 a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                               | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)           | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ .                                   |

## **DETAILED ACTION**

### ***Status of Claims***

Claims 1-50 are pending in the application. Receipt is acknowledged of amendment / response filed on July 23, 2003, and that has been entered. Claims 1, 18, 26, and 28 have been amended. Claims 10 and 25 have been canceled.

### ***Response to Election/Restriction***

Applicant's election **without traverse** of Group III, which includes claims 1-29 in paper No.5 filed on December 2<sup>nd</sup>, 2002, is acknowledged. Claims 30-50 are withdrawn from further consideration pursuant to 37 C.F.R. 1.142 (b) as being directed to non-elected subject matter. However, Examiner may reconsider to rejoin method of use claims (such as, claims 32-34) commensurate in scope with the product claims when the case would be found in condition for allowance (provided those method claims are free from 35 U.S.C. 112 first and second paragraphs). Therefore, the requirement for restriction in Paper No. 4 is still deemed proper and is therefore made FINAL.

Applicants preserve their right to file a divisional on the non-elected subject matter.

### ***Response to Arguments***

Applicant's reasoning is persuasive with respect to the rejection of claims 1-22 under 35 USC §102(b) and §103(a). The rejection has been withdrawn and Examiner regrets any inconvenience that this may have caused.

As set forth in the restriction requirement, the invention will encompass all compounds that fall within the scope of the claim is as follows:

A compound having the structure as shown in claim 1 wherein:

W is as claimed,

R<sub>1</sub> is as defined except H, C<sub>1-8</sub> alkyl,

R<sub>2</sub> and R<sub>3</sub> are as claimed except H, C<sub>1-4</sub> alkyl,

R<sub>4</sub>, R<sub>5</sub> and R<sub>6</sub> are Cl, F, and Br

R<sub>10</sub> is as claimed except H, C<sub>1-4</sub> alkyl,

R<sub>11</sub> is halo, or NO<sub>2</sub>, and

J is as claimed except C<sub>1-8</sub> alkyl,

As a result of the election and the corresponding scope of the compound identified, claims 30-50 and the remaining subject matter of claims 1-9, 11-24 and 26-29 are withdrawn from further consideration pursuant to 37 CFR 1.142 (b) as being drawn to non-elected inventions. The withdrawn subject matter of claims 30-50 is properly restricted as it differs materially in structure and in element from the elected subject matter supra so as to be patentably distinct there from.

#### *Objections*

Claims 1-9, 11-24 and 26-29 are objected to for containing non-elected subject matter. Claims drawn solely to the elected invention as identified supra, would appear allowable. The claims must be amended to exclude non-elected subject matter and within the scope of elected invention.

Therefore, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Golam Shameem, Ph.D. whose telephone number is (703) 305-0116. The examiner can normally be reached on Monday-Thursday from 6:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane, can be reached at (703) 308-4537. The Unofficial fax phone number for this Group is (703) 308-7921. The Official fax phone numbers for this Group are (703) 308-4556 or 305-3592.

When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive

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data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-1235.

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October 14, 2003